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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIM, DAVID S

ART UNIT	PAPER NUMBER
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2633

DATE MAILED: 01/28/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/881,448

Applicant(s)

MISHRA, MANAV

Examiner

David S. Kim

Art Unit

2633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-3 and 5-23.Claim(s) withdrawn from consideration: none.

8. ☒ The drawing correction filed on 02 January 2004 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance because: The Applicant's request for reconsideration introduces unpersuasive arguments. In doing so, the request for reconsideration also raises new issues related to a change in the scope of the claims. A proper and sufficient response to these new issues would require further consideration and/or search.

Applicant presents three arguments.

Regarding the first argument, Applicant refers to the specification to define terms in the claims, switching wavelengths and routing wavelengths. However, the specification does not narrowly define these terms as argued in Paper No. 9.

- Applicant relies on the following portion of the specification, "In one embodiment, one set of wavelengths (one or more switching wavelengths) may be used as labels to indicate that the traffic is to be switched in the optical domain using the optical circuit switching. Another set of wavelengths (one or more wavelengths) may be used as labels to indicate that traffic is to be routed" (application, p. 7, lines 11-15).

- Applicant states, "Applicant's Specification defines switching wavelengths as 'labels to indicate that the traffic is to be switched in the optical domain using the optical circuit switching' and routing wavelengths as 'labels to indicate that traffic is to be routed' (page 7, lines 11-15). The Applicant's Specification also defines routed traffic as 'typically undergo[ing] an optical to electrical conversion, software processing, and conversion back to the electrical domain from the optical domain. (Page 7, lines 1-5.)' (Paper No. 9).

Applicant's argument that "Applicant's Specification defines..." implies the necessary inclusion of limitations (labels to indicate that the traffic is to be switched in the optical domain using the optical circuit switching, labels to indicate that traffic is to be routed, optical to electrical conversion and conversion back to the electrical domain from the optical domain) that are not explicitly stated in the claims. Note that the portions of the specification on which Applicant relies do not define the terms, switching wavelengths and routing wavelengths, as narrowly as Applicant argues. In particular, the degree of definition is broadly expressed by the usage of "may be used as" and "typically." Examiner respectfully maintains the position that the specification does not define the terms (switching wavelengths and routing wavelengths) so narrowly as to necessitate reading the inclusion of these limitations into the present version of the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Therefore, Applicant's first argument is unpersuasive. Thus, should Applicant desire consideration of these limitations on their merits, explicit inclusion of these limitations is encouraged. Accordingly, these limitations raise new issues related to a change in the scope of the claims. A proper and sufficient response to these new issues would require further consideration and/or search.

Regarding the second argument, Applicant asserts, "Examiner has not met the initial burden of factually supporting any prima facie conclusion of obviousness" (Paper No. 9). Applicant relies on an improper reference by Examiner to the prior art of record as the basis for this argument. Examiner referred to "p. 600, last paragraph" of Ghani. However, Ghani does not contain a "p. 600." Rather, the intended reference was "p. 53, col. 1, last paragraph." Examiner apologizes for any resulting confusion and inconvenience. However, the standing rejection was in good faith, and the factual evidence was available to Applicant in the text of the prior art of record (Ghani). Therefore, Applicant's second argument is unpersuasive.

Regarding the third argument, Applicant contends the standing rejections of claims 15 and 17-21 under 35 U.S.C. 103(a),

"Applicant respectfully submits that the Examiner has improperly gleaned a rationale from Applicant's Specification. In fact, the Examiner cites specific passages from Applicant's Specification as the basis for the rationale. The Examiner has not pointed to any rationale taught or suggested in Ghani. Applicant respectfully submits that the Examiner has used impermissible hindsight as a rationale to render the claimed invention obvious in violation of MPEP 2144" (Paper No. 9, p. 14, 1st full paragraph).

In response, Examiner notes that Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Gleaning a rationale from Applicant's specification (or not gleaning) and pointing to any rationale taught or suggested in Ghani are beside the point. "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art" (MPEP 2144). Examiner cited passages from Applicant's Specification that indicate prior art, knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made:

- "Circuit switched networks are generally regarded as high-speed and there is certainty that information will reach its destination" (application, p. 3, lines 6-7).

- "Packet switched networks are generally regarded as slow. Moreover, there is usually no guarantee that a packet will reach its intended destination" (application, p. 1, lines 24-26).

While this knowledge is cited from Applicant's Specification, it does not constitute knowledge that is gleaned only from applicant's disclosure. Rather, the plain text of these citations comprise admissions by Applicant that they are prior art and were generally available to one of ordinary skill in art at the time the invention was made.

As for providing a rationale, "[t]he strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination" (MPEP 2144). From a plain reading of these two citations, "[a]t the time the invention was made, it would have been obvious to a person of ordinary skill in the art to determine whether or not all traffic is to be directed to [circuit] switching logic. One of ordinary skill in the art would have been motivated to do this to try to take advantage of the speed and integrity of circuit switched networks before resorting to the alternative of routing [packets] with its slower speed and lower integrity" (standing rejection, Paper No. 8, p. 6, 2nd middle paragraph).

Examiner respectfully maintains the position that the standing rejections rely on prior art (Applicant's admission). Examiner also respectfully maintains the position that the combination of Ghani and said prior art is supported by a strong rationale, as presented in the standing rejections (Paper No. 8, p. 6, middle paragraph). Therefore, Applicant's third argument is unpersuasive.

Summarily, Applicant's three arguments are unpersuasive. Therefore, Examiner respectfully maintains the standing rejections.

Continuation of 10. Other: Applicant requested clarification as to the rejection of certain claims. In particular, Applicant directed attention to Examiner's treatment of claims 4, 15, and 17-19 in Paper No. 8.

Regarding claim 4, Applicant notes, "[I]n paragraph 4 of the Office Action, the Examiner rejected claims 1-6 under 35 U.S.C. 102(e)....However, claim 4 was cancelled in a previous Amendment" (Paper No. 9, p. 9, 2nd paragraph). Examiner agrees. In response to the cancelled status of claim 4, Examiner's intent was to indicate rejection of claims 1-3 and 5-6. Examiner apologizes for any resulting confusion and inconvenience.

Regarding claims 15 and 17-19, Applicant notes, "On page 5 of the Office Action, the Examiner then rejects claims 15 and 17-19 under 35 U.S.C. 102(b) as anticipated by Ghani, but the arguments are arguments that go to obviousness under 35 U.S.C. 103(a). Applicant will address rejection of claims 15, and 17-21 under 35 U.S.C. 103(a) because no bases were presented for rejection of claims 15, and 17-21 under 35 U.S.C. 102(b)" (Paper No. 9, p. 9, 3rd paragraph). Examiner agrees. Examiner's intent was to reject claims 15 and 17-19 under 35 U.S.C. 103(a), as noticed by Applicant. A portion of the standing rejections reads, "Claims 15 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghani" (Paper No. 8, p. 5). This portion is a typographical error. Examiner apologizes for any resulting confusion and inconvenience.



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